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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,759	06/23/2005	Eva-Maria Leppanen	59643.00602	9073
32294 7590 05/22/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER				
RICKET, JASON D				
ART UNIT		PAPER NUMBER		
2142				
MAIL DATE		DELIVERY MODE		
05/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/530,759

Applicant(s)

LEPPANEN ET AL.

Examiner

JASON RECEK

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to the amendment filed November 30th 2007 which concerns application 10/530759.

Status of Claims

Claims 1-31 are pending.

Response to Arguments

1. Applicant's requests the provisional double patenting rejection to be held in abeyance. The examiner agrees to hold this rejection in abeyance until allowable subject matter is indicated.
2. Applicant's arguments, see pg. 11-12, filed 11/30/07, with respect to the claim objections and 35 U.S.C. 112 rejections have been fully considered and are persuasive. The claim objections and 35 U.S.C. 112 rejections have been withdrawn. However in light of the amendments a new claim objection is made.

3. Applicant's arguments filed 11/30/07 have been fully considered but they are not persuasive. Applicant argues that Agrawal does not teach or suggest that only certain elements of presence information is provided, specifically that Agrawal does not disclose "an information providing unit configured to provide information defining for said at least one user of said group which elements of said presence information to be provided" as recited by the pending claims (pg. 16-17). This argument is not persuasive. Agrawal does in fact disclose configuring presence information and only providing that information which is requested. For example, Agrawal discloses that presence information can be configured to indicate when a user will become available or when a user logs on or off an application (paragraph 41). This disclosure would lead one of ordinary skill in the art to understand this information may be sent but it is not always sent, and thus Agrawal discloses providing certain elements of presence information.

Also, Applicant incorrectly asserts that Agrawal requires applications to use presence data in a standard manner. Agrawal clearly disclose that applications **can be** configured to use or provide user presence data in a standard manner (paragraph 39).

4. Applicant has attempted to disqualify reference Requena US 2007/0124472 under 35 U.S.C. 103(c) by showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as Requena at the time this invention was made. However, applicant has failed to provide a statement that the application and the reference were owned by, or subject to an obligation of assignment to, the same person

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at the time the invention was made in a conspicuous manner, and therefore, is not disqualified as prior art under 35 U.S.C. 103(a). Applicant must file the required evidence in order to properly disqualify the reference under 35 U.S.C. 103(c). See MPEP § 706.02(I).

In addition, applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

Claim Objections

1. Claim 1 is objected to because of the following informalities: the phrase "which elements of said presence information to be provided" should read 'which elements of said presence information are to be provided' as recited in Applicant's arguments pg.
12. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-17 and 21-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Agrawal US 2002/0083127 A1.

Regarding claim 1, Agrawal discloses "a plurality of users with which presence information is associated" as multiple users having user presence data (pg. 2 paragraph 24, Fig. 1), "said presence information comprising a plurality of parts" as presence data may indicate multiple conditions (pg. 2 paragraph 25), "means for storing information defining at least one group, said group containing a plurality of users" as a buddy list (pg.2 paragraph 26), "means for providing information defining for said at least one user of said group what parts of said presence information are to be provided" as configuring user presence data to indicate specific states for certain users (pg. 4 paragraph 41).

Regarding claim 2, Agrawal discloses "said parts of said presence information is provided to at a requester in response to request from said requester" as providing presence data from the server to the client (pg. 3 paragraph 39, Fig. 4).

Regarding claim 3, Agrawal discloses "wherein said requester is one of said plurality of said users" as a user who configures their buddy list to show presence data of others is a requester of that data (pg. 2 paragraph 26).

Regarding claim 4, Agrawal discloses "said parts of said presence information is available only to one requester or to a plurality of requesters" as controlling who has access to presence information (pg. 4 paragraph 49).

Regarding claim 5, Agrawal discloses "said parts of said information provided is dependent on the identity of the requester" as only showing presence information to certain people (pg. 4 paragraph 49).

Regarding claim 6, Agrawal discloses "means for determining the identity of the requester making said request" as a buddy list user would necessary know the identity of the other users receiving the presence information (pg. 4 paragraph 41).

Regarding claim 7, Agrawal discloses "said storing means comprises a presence server" as a presence server (pg. 2 paragraph 24, Fig. 1).

Regarding claim 8, Agrawal discloses "said means for providing said information comprises a storage means" as an application server having a presence repository (pg. 4 paragraph 42, Fig. 11).

Regarding claim 9, Agrawal discloses "said means for storing and said providing means are provided by a common storage means" as a presence server and an

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application server that have access to a common presence repository (pg. 4 paragraph 41-42, pg. 5 paragraph 53, Fig. 11).

Regarding claim 10, Agrawal discloses "said means for providing said information comprises one of said users" as a user that provides presence information about himself (pg. 4 paragraph 49).

Regarding claim 11, Agrawal discloses "a separate address is provided for each of a plurality of groups" as using protocols HDTP/HDML or WAP or TCP/IP each message would have a unique address, thus each group would have a separate address (pg. 2 paragraph 27-9).

Regarding claim 12, Agrawal discloses "said users comprise user equipment" as a client/user consisting of a mobile device (pg. 2 paragraph 24, Fig. 1).

Regarding claim 13, Agrawal discloses "said presence information comprises at least one of the following parts of information: Subscriber status; Network status; communication means; Contact address, Subscriber provided location; Network provided location; text; priority; mood, favourite colour" as presence information includes at least network status – available or unavailable (pg. 2 paragraph 25) but may also include contact information and location (pg. 4 paragraph 41).

Regarding claim 14, Agrawal discloses "providing means provides information as to the parts of said presence information required" as providing the presence information requested (pg. 2 paragraph 25, pg. 3 paragraph 39).

Regarding claim 15, Agrawal discloses "providing means provides information as to the parts of said presence information not required" as providing more information than simply available or unavailable but also providing whether a user is available by cell phone, this information will often not be required for purposes of deciding whether a user is available to receive a message (pg. 4 paragraph 41, 48).

Regarding claim 16, Agrawal discloses "the parts of the presence information to be obtained is the same for all of at least one group" as configuring a buddy list to identify who is available, thus the same information is provided for all of the group (pg. 4 paragraph 41).

Regarding claim 17, Agrawal discloses "the parts of the presence information to be obtained are different for at least two users at least one group" as configuring a buddy list to identify who is available and configuring a buddy list to identify who is not available but reachable, thus different presence information is being obtained (pg. 4 paragraph 41).

Regarding claim 21, Agrawal discloses "said storing means is arranged to receive presence information from the users of said group" as presence information is sent from the users to the server where it is stored (pg. 2 paragraph 25).

Regarding claim 22, Agrawal discloses "said storing means is arranged to provide the parts of the presence information to be provided" as the server provides the presence information to other users (pg. 4 paragraph 41).

Regarding claims 23-24, Agrawal discloses "an entity associated with a user or a user of the group is arranged to provide to the parts of the presence information to be provided" and "said entity comprises a presence server" as a presence server associated with the users that provides presence information (pg. 2 paragraph 24, Fig. 1).

Regarding claim 25, Agrawal discloses "said storing means is arranged to add said parts of presence information to a request sent to said user or an entity associated with said user" as delivering an acknowledgment to the message originator concerning the user presence information (pg. 4 paragraph 44).

Regarding claim 26, Agrawal discloses "said storage means receives from said requester, said storage means inserts the parts of presence information into a request sent to said user or an entity associated with said user" as an application where a user

configures a buddy list to inform user presence data, thus the storage means is inserting the user presence data for the requester (pg. 2 paragraph 26, pg. 3 paragraph 39, pg. 4 paragraph 41).

Regarding claim 27, Agrawal discloses "defining at least one group containing a plurality of users with which presence information is associated, said presence information comprising a plurality of parts" as a buddy list where users have presence information associated with them that comprises a plurality of parts (pg. 2 paragraph 26, pg. 4 paragraph 41), "defining for said at least one user of said group what parts of said presence information are to be provided" as specifying what presence information to receive (pg. 4 paragraph 41).

Regarding claim 28, Agrawal discloses "the step of filtering the presence information for at least one user of the group to obtain the defined parts of said presence information" as a user configuring what presence information to show and to whom, thus the presence information is "filtered" (pg. 4 paragraph 49).

Regarding claim 29, Agrawal discloses "the step of requesting for at least one user of said group said defined parts of said presence information" as a user wanting to know the presence information of another user of a group (pg. 3 paragraph 39).

Regarding claim 30, Agrawal discloses "means for storing first information defining at least one group, said group containing a plurality of users with which presence information is associated" as a buddy list that contains several users each user having presence information (pg. 2 paragraph 26), "said presence information comprising a plurality of parts" as presence information that comprises at least network status (pg. 2 paragraph 25, pg. 4 paragraph 41), and "second information defining for said at least one user of said group what parts of said presence information are to be provided" as a user configuring what parts of presence information to provide (pg. 4 paragraph 49).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of Requena US 2007/0124471 A1.

Regarding claim 18, Agrawal does not disclose "the system operates in accordance with a session initiation protocol (SIP)" however this is taught by Requena as a presence information system that uses SIP (pg. 5 paragraph 73, pg. 13 paragraph 180-4, Fig. 11-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object of the invention, thus it would be natural to use SIP for the purpose of operating the system.

Regarding claim 19, Agrawal does not disclose "request for said presence information is made in a SUBSCRIBE request" however this is taught by Requena as a SUBSCRIBE request (pg. 13 paragraph 183, Fig. 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object of the invention, thus it would be natural to use SIP for the purpose of operating the system.

Regarding claim 20, Agrawal does not disclose "the providing means comprise a SIP SUBSCRIBE message" however this is taught by Requena as a SUBSCRIBE message sent to the SIP server (pg. 13 paragraph 183, Fig. 11).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Agrawal with the SIP message SUBSCRIBE taught by Requena. The motivation for using SIP is that SIP carries presence information which is the object of the invention, thus it would be natural to use SIP for the purpose of operating the system.

/Andrew Caldwell/
Supervisory Patent Examiner, Art Unit 2142